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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,335	08/04/2003	Jean-Marc DuFour	DRXI-0144	6769
23377	7590	08/24/2005	EXAMINER	
WOODCOCK WASHBURN LLP ONE LIBERTY PLACE, 46TH FLOOR 1650 MARKET STREET PHILADELPHIA, PA 19103			JONES, DAMERON LEVEST	
			ART UNIT	PAPER NUMBER
			1618	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,335

Applicant(s)

DUFOUR, JEAN-MARC

Examiner

D. L. Jones

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20-29, 31 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20-29, 31, and 34-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the amendment filed 6/10/05 wherein claims 1-5, 8-13, 15-18, 20-22, and 31 are amended; claims 19, 30, 32, and 33 are canceled; and claims 34-36 are added.

Note: Claims 1-18, 20-29, 31, and 34-36 are pending.

RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS

2. The Applicant's arguments filed 6/10/05 to the rejection of claims 1-5, 8-13, 15-22, 25, and 29-33 made by the Examiner under 35 USC 112 and/or double patenting have been fully considered and deemed persuasive because Applicant has amended the claims to overcome the rejections. Therefore, the said rejections are hereby withdrawn.

NEW GROUNDS OF REJECTIONS

112 First Paragraph Rejections

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-18, 20-29, 31, and 34-36 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for Compounds 1-33 as set forth in the specification comprising a chelating moiety, does not reasonably provide enablement for all compounds as set forth in independent claims 1, 9, and 16 wherein

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R1 is a protective agent; R2 is an activated ester, a carboxylic acid, an alkyl isothiocyanate, an aromatic isothiocyanate, or a leaving group, and R3-R5 are protective groups. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

There are several guidelines when determining if the specification of an application allows the skilled artisan to practice the invention without undue experimentation. The factors to be considered in determining what constitutes undue experimentation were affirmed by the court in *In re Wands* (8 USPQ2d 1400 (CAFC 1986)). These factors are (1) nature of the invention; (2) state of the prior art; (3) level of one of ordinary skill in the art; (4) level of predictability in the art; (5) amount of direction and guidance provided by the inventor; (6) existence of working examples; (7) breadth of claims; and (8) quantity of experimentation needed to make or use the invention based on the content of the disclosure.

(1) Nature of the invention

The claims are directed to compounds and uses thereof as set forth in independent claims 1, 9, and 16 having the structures therein.

(2) State of the prior art

The references of record do not indicate which protective groups, activated esters, carboxyl acids, alkyl isothiocyanates, aromatic isothiocyanates, and leaving groups are useful with the claimed invention.

(3) Level of one of ordinary skill in the art

The level of one of ordinary skill in the art is high. Independent claims 1, 9, and 16 encompass a vast number of possible protective groups, activated esters, carboxyl acids, alkyl isothiocyanates, aromatic isothiocyanates, and leaving groups. Applicant's specification does not enable the public to make or use such a vast number of possible protective groups, activated esters, carboxyl acids, alkyl isothiocyanates, aromatic isothiocyanates, and leaving groups be used in combination with all possible chelating moieties.

(4) Level of predictability in the art

The art pertaining to chelating moieties containing protective groups, activated esters, carboxyl acids, alkyl isothiocyanates, aromatic isothiocyanates, and/or leaving groups is highly unpredictable. Determining the various types of protective groups, activated esters, carboxyl acids, alkyl isothiocyanates, aromatic isothiocyanates, and/or leaving groups that are useful with a desired chelator requires various experimental procedures and without guidance that is applicable to all chelating moieties, there would be little predictability in performing the claimed invention.

(5) Amount of direction and guidance provided by the inventor

Independent claims 1, 9, and 16 encompass a vast number of protective groups, activated esters, carboxyl acids, alkyl isothiocyanates, aromatic isothiocyanates, and/or leaving groups. Applicant's limited guidance does not enable the public to prepare such a numerous amount of compounds containing the protective groups, activated esters, carboxyl acids, alkyl isothiocyanates, aromatic isothiocyanates, and/or leaving groups combinations. There is no directional guidance for the all the possible protective

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groups, activated esters, carboxyl acids, alkyl isothiocyanates, aromatic isothiocyanates, and/or leaving groups that are useful with a desired chelating moiety. Hence, there is no enablement for all possible permutations and combinations of the protective groups, activated esters, carboxyl acids, alkyl isothiocyanates, aromatic isothiocyanates, and/or leaving groups.

(6) Existence of working examples

Independent claims 1, 9, and 16 encompass a vast number of compounds. Applicant's limited working examples do not enable the public to prepare such a numerous amount of protective groups, activated esters, carboxyl acids, alkyl isothiocyanates, aromatic isothiocyanates, and/or leaving groups combinations. While Applicant's claims encompass a plethora of possible protective groups, activated esters, carboxyl acids, alkyl isothiocyanates, aromatic isothiocyanates, and/or leaving groups combinations, the specification provides only for Compounds 1 – 33.

(7) Breadth of claims

The claims are extremely broad due to the vast number of possible protective groups, activated esters, carboxyl acids, alkyl isothiocyanates, aromatic isothiocyanates, and/or leaving groups known to exist.

(8) Quantity of experimentation needed to make or use the invention based on the content of the disclosure

The specification does not enable any person skilled in the art to which it pertains to make or use the invention commensurate in scope with the claims. In particular, the specification fails to enable the skilled artisan to practice the invention without undue

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experimentation. Furthermore, based on the unpredictable nature of the invention, the state of the prior art, and the extreme breadth of the claims, one skilled in the art could not perform the claimed invention without undue experimentation.

112 Second Paragraph Rejections

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-18, 20-29, 31, and 34-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-18, 20-29, 31, and 34-36: The claims as written are ambiguous because it is unclear what specific protective groups, activated esters, carboxylic acids, alkyl isothiocyanate, aromatic isothiocyanate, and/or leaving groups that Applicant is intending to be compatible with the instant invention. In particular, the claims are indefinite because the specification discloses a limited number of the groups, but the claims read on any and all possible protective groups, activated esters, carboxylic acids, alkyl isothiocyanate, aromatic isothiocyanate, and/or leaving groups. Hence, one cannot readily ascertain what is being claimed.

Claims 26-29, 31, and 34-36: The claims as written are ambiguous because it is unclear what the method is. For example, are the claims directed to 'a method of imaging', etc. Hence, one cannot readily ascertain what is being claimed.

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COMMENTS/NOTES

7. It is duly noted that no prior art has been cited against the instant invention. However, Applicant MUST address and overcome the 112 rejections above. The claims are distinguished over the prior art of record for reasons of record in the office action mailed 3/8/05.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


D. L. Jones
Primary Examiner
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August 22, 2005